

## **REMARKS**

### **Statement Regarding The Substance of An Interview**

Applicants' representative spoke with Examiner Jacyna in a phone conversation on December 9, 2010. Applicants appreciate Examiner Jacyna taking the call and discussing this case. The content of the Interview Summary prepared by Examiner Jacyna and mailed on December 16, 2010 is a complete recordation of the substance of the interview.

### **Rejections under 35 U.S.C. § 102(b)**

Claims 2 and 5-7 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Dyer et al. (U.S. Patent No. 6,450,214). The Applicants respectfully disagree because Dyer does not teach the type of universal collar defined in the claims. In particular, the pending claims define a universal collar used in a dispenser having a keyplate, with this feature being recited in the preamble of both pending independent claims ("A universal collar ... used in a dispenser having a keyplate...").

#### **Whether A Preamble Limits A Claim**

Whether a preamble limits a claim is made on a case-by-case basis in light of the facts in each case; there is no litmus test defining when a preamble limits the scope of a claim.<sup>1</sup> "[A] claim preamble has the import that the claim as a whole suggests for it."<sup>2</sup> "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim."<sup>3</sup> Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation.<sup>4</sup> The MPEP acknowledges that a "preamble may provide context for claim

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<sup>1</sup> *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002).

<sup>2</sup> *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995).

<sup>3</sup> *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999).

<sup>4</sup> See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989) (The determination of whether preamble recitations are structural limitations can be resolved only on review of the entirety of the application "to gain an understanding of what the inventors actually invented and intended to encompass by the claim."); *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801, 14 USPQ2d 1871, 1876 (Fed. Cir. 1990) (determining that preamble language that constitutes a structural limitation is actually part of the claimed invention). See also *In re Stencel*, 828 F.2d 751, 4 USPQ2d 1071 (Fed.

construction, particularly, where as here, that preamble's statement of intended use forms the basis for distinguishing the prior art in the patent's prosecution history." See, MPEP § 2111.02, citing *Metabolite Labs., Inc. v. Corp. of Am. Holdings*, 370 F.3d 1354, 1358-62, 71 USPQ2d 1081, 1084-87 (Fed. Cir. 2004).

#### The Pending Claims: The Preamble Gives Them Life, Meaning, and Vitality

In the pending claims, the preamble recites the environment in which the claimed universal collar is used: "A universal collar ... used in a dispenser having a keyplate..." Paragraphs [0003]-[0005] of the present application introduce dispensers having keying arrangements and some of the problems associated with such dispensers. One of skill in the dispenser arts would certainly appreciate that dispensers having keying arrangements are structurally different from dispensers not having keying arrangements. The dispenser of Dyer does not have a keying arrangement, and therefore does not have the structural features associated with such keying arrangements, including keyplates, keyways, and the like. Thus, the recitation in the preambles of "A universal collar ... used in a dispenser having a keyplate..." situates the invention in a particular environment that is different from the cited art.

Moreover, the environment in which the claimed invention is used relates to the structure of the universal collar because, again, dispensers having keying arrangements are structurally different from dispensers not having keying arrangements. For example, claim 1 recites several structural features of the universal collar that relate to the environment of a dispenser having a keyplate with a keyway: "a body defining an axial bore and having a first flange and a second flange, said bore extending at least between said first flange and said second flange, wherein said flanges extend radially outward and are axially spaced from each other for receiving the keyplate therebetween, wherein said body includes a keyless surface between said first and second flanges such that the universal collar bypasses the keyway of the dispenser..." (emphasis added to highlight structural features of universal collar relating to

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Cir. 1987). (The claim at issue was directed to a driver for setting a joint of a threaded collar; however, the body of the claim did not directly include the structure of the collar as part of the claimed article. The examiner did not consider the preamble, which did set forth the structure of the collar, as limiting the claim. The court found that the collar structure could not be ignored. While the claim was not directly limited to the collar, the collar structure recited in the preamble did limit the structure of the driver. "[T]he framework - the teachings of the prior art - against which patentability is measured is not all drivers broadly, but drivers suitable for use in combination with this collar, for the claims are so limited." Id. at 1073, 828 F.2d at 754.).

dispenser having a keyplate with a keyway). Dispensers not having a keying arrangement (such as the dispenser in Dyer) do not have a keyplate, and the features of the claimed universal collar therefore do not relate to such dispensers.

Similarly, claim 5 recites structural features of the universal collar that relate to the environment of a dispenser having a keyplate: “a body defining an axial bore and having a first flange and a second flange, said bore extending at least between said first flange and said second flange, wherein said flanges extend outward and are axially spaced from each other for receiving the keyplate therebetween...” (emphasis added to highlight structural features of universal collar relating to dispenser having a keyplate). Like with respect to claim 2, dispensers that do not have a keying arrangement do not have a keyplate, and the features of the claimed universal collar therefore do not relate to such dispensers.

Thus, the preamble gives life, meaning, and vitality to the claims, and the use and structure of the claimed invention distinguishes it over the cited art. The Dyer reference does not disclose a dispenser having a keying arrangement, and therefore does not include a keyplate or a keyway. Consequently, the collar shown in Dyer does satisfy the structural limitations of the claimed universal collar, which is used in a dispenser having a keyplate. Dyer does not teach: (1) a universal collar having flanges extending radially outward and being axially spaced from each other for receiving the keyplate therebetween, (2) a universal collar having a body including a keyless surface between the first and second flanges such that the universal collar bypasses the keyway of the dispenser, or (3) a universal collar having a body defining an axial bore and having a first flange and a second flange, the bore extending at least between the first flange and the second flange, and wherein the flanges extend outward and are axially spaced from each other for receiving the keyplate therebetween.

Conclusion

In light of the foregoing, a Notice of Allowance of all pending claims is earnestly solicited. Should the Examiner wish to discuss any of the foregoing in more detail, the undersigned attorney would welcome a telephone call.

In the event that any fees are due with the filing of this Amendment, the Commissioner is hereby authorized to charge deposit account 18-0987.

Respectfully submitted,

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Mark L. Weber, Reg. No. 46,069  
Renner, Kenner, Greive, Bobak, Taylor & Weber  
First National Tower - Fourth Floor  
Akron, Ohio 44308-1456  
Telephone: (330) 376-1242  
Facsimile: (330) 376-9646  
Attorney for Applicant(s)

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